

REMARKS

In the Office Action¹, the Examiner took the following actions:

rejected claims 1-21 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 6-12 of co-pending U.S. Patent Application No. 10/720,920 (the '920 application);

rejected claims 1-21 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-37 and 110 of co-pending U.S. Patent Application No. 10/858,973 (the '973 application);

rejected claims 1-22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,130,390 to Abburu ("Abburu") in view of U.S. Patent No. 5,661,788 to Chin ("Chin") in view U.S. Patent No. 7,209,955 to Major et al. ("Major"); and

rejected claims 1, 12, 15, and 19 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Publication No. 2001/0012286 to Huna et al. ("Huna") in view of Abburu and Chin.

By the present amendment, Applicants have amended claims 1, 7, 12, 19, and 22, canceled claims 15-18 without prejudice or disclaimer, and added new claims 23-26. Claims 1-14 and 19-26 are pending in this application.

I. Nonstatutory double patenting rejections of Claims 1-21

In the Final Office Action the Examiner rejected claims 1-21 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 6-12 of the '920 application, and over claims 1-37 and 110 of the '973 application. (Final Office Action at pages 2-3). Applicants respectfully traverse the nonstatutory obviousness-type double patenting rejections of claim 1-21 for the following reasons.

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

The Office Action alleges that "claim 1 of the pending application [is] the same as claim 1 of the co-pending ['920] application except receiving a notification at a server" (Office Action at page 3). This is incorrect. Even assuming the Examiner's allegation was correct at some point during the prosecution of this application (a position Applicants do not concede), the Examiner's position does not appear to take account of amendments presented in both this application and the '920 application.

Similarly, the Office Action alleges that "claim 1 of the pending application [is] the same as claim 1 of the co-pending ['973] application except [for the] displaying step" (Office Action at page 3). Again, this statement is incorrect, and the Examiner does not appear to have taken account of amendments presented in both this application and the '973 application.

Moreover, as Applicants have previously pointed out, the double patenting rejection is improper, and any double patenting rejection over the claims of copending applications should be a provisional double patenting rejection (See Amendment filed September 4, 2008 at pages 8-9 including footnote 2 and Amendment filed January 23, 2009, pages 8-9). However, the Office Action does not address this point and instead simply reiterates the double patenting rejection from the previous Office Action. Nevertheless, because any nonprovisional double patenting rejection would be improper at this time, Applicants respectfully request that the double patenting rejections be held in abeyance and any resolution in the form of a Terminal Disclaimer or otherwise be deferred.

II. Rejection of Claims 1-22 under 35 U.S.C. § 103(a)

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-22 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established with respect to these claims. Claims 15-18 have been canceled, rendering the rejection moot with respect to these claims.

Claim 1 recites a method comprising "converting the incoming call data from the data format for the calling device into a data format for the preferred device to generate a notification of the incoming call."

Abburi discloses a system and method by which individuals can send or receive audio messages using telephone devices or computer devices (*Abburi*, abstract). *Abburi*'s system contacts the intended recipient to notify the recipient of the received audio message, and delivers the message to the intended recipient in audio form through either a telephone or computer (*Abburi*, abstract). If the recipient specifies that audio messages should be received as email notifications, the system generates an email notification to the user (*Abburi*, col. 6, lines 22-33). Alternately, if the recipient specifies that they should be notified of the audio message by phone, the system places a call to the recipient and notifies the recipient of the message using synthesized or prerecorded speech (*Abburi*, col. 6, lines 34-39).

However, *Abburi*'s audio messages cannot constitute the claimed "notification of the incoming call," as *Abburi*'s audio messages provide no notification of incoming calls. Instead, *Abburi*'s audio messages are messages that a user wishes to record and then send to the recipient (See *Abburi*, col. 1, lines 54-59, col. 2 lines 58-65). Because *Abburi*'s audio messages provide no notification of incoming calls, *Abburi* does not

teach or suggest "converting the incoming call data from the data format for the calling device into a data format for the preferred device to generate a notification of the incoming call," as recited by independent claim 1.

Chin fails to cure these deficiencies of *Abburi*. *Chin* discloses a method and system for selectively answering incoming telephone calls based on a user-selected receiving mode (*Chin*, abstract). *Chin*'s modes include modes where users are alerted to all incoming calls, or only to incoming calls from specific telephone numbers (*Chin*, col. 3, lines 47-57). *Chin* also discloses selectable "alert modes" where the user can be provided with a ringing signal and/or a visual display of the calling party's telephone number, or a voice message indicating the telephone number of the calling party (*Chin*, col. 3, line 58 to col. 4, line 3). However, both the caller and called party in *Chin* use telephones to communicate using dual tone multi-frequency (DTMF) signals (*Chin*, col. 2, lines 10-11). Accordingly, *Chin* does not "convert" data from the incoming call into a format for the user's telephone. Thus, *Chin* does not teach or suggest "converting the incoming call data from the data format for the calling device into a data format for the preferred device to generate a notification of the incoming call," as recited by independent claim 1.

Major fails to cure these deficiencies of *Abburi* and *Chin*. *Major* discloses a notification system and method for a mobile data communication device (*Major*, abstract). A user can configure certain data items, such as email messages and meeting notifications, to be redirected to their mobile communication device (*Major*, col. 8, lines 47-54). *Major* also discloses a "notification scheme" that provides a user with notification alerts such as audible or vibrating alerts (*Major*, col. 11, lines 49-51).

However, *Major* does not disclose or suggest, for example, that incoming call data is converted into a data format for the user's mobile communication device. Therefore, *Major* does not teach or suggest "converting the incoming call data from the data format for the calling device into a data format for the preferred device to generate a notification of the incoming call," as recited by independent claim 1.

Accordingly, no *prima facie* case of obviousness has been established for independent claim 1. Independent claims 12 and 19, while of different scope, recite features similar to those of claim 1 and are thus allowable over *Abburi*, *Chin*, and *Major* for reasons similar to those discussed above in regard to claim 1. Claims 2-11, 13, 14, and 20-22 are also allowable at least due to their dependence from one of the independent claims.

III. Rejection of Claims 1, 12, 15, and 19 under 35 U.S.C. § 103(a)

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1, 12, 15, and 19 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established with respect to these claims. Claim 15 has been canceled, rendering the rejection moot with respect to claim 15. As already discussed, *Abburi* and *Chin* fail to teach or suggest "converting the incoming call data from the data format for the calling device into a data format for the preferred device to generate a notification of the incoming call," as recited by independent claim 1, or the similar recitations of independent claims 12 and 19.

Huna fails to cure these deficiencies of *Abburi* and *Chin*. *Huna* discloses an apparatus and method for alerting a user upon receipt of selected messages, independent of the type of device generating the message (*Huna*, abstract). *Huna* also

discloses that the message generating devices can include telephony devices such as telephones or fax machines, as well as data devices such as computers and PDA's (*Huna*, abstract). *Huna*'s method provides users with audible or visual alerts of faxes, voicemails or emails (*Huna*, ¶ 16).

Huna also discloses a "ThinkLink" interface that allows bi-directional communications between a computer and telephone (*Huna*, ¶ 43). The ThinkLink interface may convert an email into a voice message for playback on the telephone, or convert faxes for delivery via email (*Huna*, ¶ 43). However, *Huna* does not disclose or suggest that the messages include incoming call data, and do not relate to incoming calls. Accordingly, even assuming *Huna*'s messages are "converted" between various formats, they are not converted to generate notifications of incoming calls, but rather merely to convert the message to an email, fax, or voice message. Accordingly, *Huna* does not teach or suggest "converting the incoming call data from the data format for the calling device into a data format for the preferred device to generate a notification of the incoming call," as recited by independent claim 1, or the similar recitations of independent claims 12 and 19.

For the reasons discussed above, no *prima facie* case of obviousness has been established for independent claims 1, 12, and 19.

IV. Conclusion

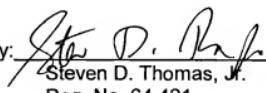
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 
Steven D. Thomas, Jr.
Reg. No. 64,421